

**AMENDMENTS TO THE DRAWINGS**

The attached replacement sheet includes an amendment to Figure 8.

**REMARKS**

Claims 1-14 and 23-30 are pending in the application. Claims 15-22 have been canceled. Claims 23-30 have been added. Claims 1, 3-4, 6, 9, and 11-12 have been amended. Applicant respectfully submits that no new matter has been added. Applicant respectfully requests reconsideration of the application in view of the foregoing amendments and the following remarks.

**I. Amendment to the Drawings**

In the attached replacement sheet, Applicant has amended Figure 8 to correct a typographical error. Specifically, block 801 of FIG. 8 has been amended to correctly spell the word "element."

**II. Rejection under 35 U.S.C. § 101**

Claims 1-8 stand rejected under 35 U.S.C. § 101 as being directed to unpatentable subject matter.<sup>1</sup> Claim 1 has been amended to explicitly tie various features to at least one server in a computing system. Claim 1 has additionally been amended to clarify that a knowledge base is resident in a computer-readable storage medium in the computing system. Applicant respectfully submits that claim 1 is directed to patentable subject matter. Applicant respectfully requests that the rejection under 35 U.S.C. § 101 of claim 1 be withdrawn.

Claims 2-8 depend from and further restrict independent claim 1. Applicant respectfully submits that, for at least the reasons given with respect to claim 1, claims 2-8 are also directed to patentable subject matter. Applicant respectfully requests that the rejection under 35 U.S.C. § 101 of claims 2-8 be withdrawn.

**III. Rejection under 35 U.S.C. § 102****A. Claim 1**

Claims 1-22 stand rejected under 35 U.S.C. § 102 as anticipated by U.S. Patent Publication No. 2002/0128874 to McIntosh et al. ("McIntosh"). Applicant respectfully traverses.

The standard for anticipation is one of *strict identity*.<sup>1</sup> The Federal Circuit has continually stressed that anticipation is established only if: (1) all of the features of an invention, as stated in a patent claim; (2) are identically set forth; (3) in a single prior art reference.<sup>2</sup> There must be no difference between the claimed invention and the reference disclosure.<sup>3</sup> As set forth in detail below, Applicant respectfully submits that McIntosh fails to survive this standard for all pending claims.

McIntosh discloses a computer-implemented warranty knowledge base construction system and method. McIntosh's system is designed to process vehicle warranty claims generated from various vehicle dealerships. Towards that end, McIntosh teaches use of a "knowledge base expert system" that evaluates input warranty data and additional data from a database. McIntosh's knowledge base expert system includes warranty business rules used for the evaluation. Applicant respectfully submits that McIntosh fails to disclose several features of independent claim 1.

Initially, McIntosh provides no relevant disclosure for the required feature of independent claim 1 of *creating at least one claim element based on information related to a field from a claim form*. For this reason alone, Applicant respectfully submits that independent claim 1 distinguishes over McIntosh.

In addition, even if it is assumed for the sake of argument, without conceding, that McIntosh's "knowledge base expert system" can be a knowledge base according to independent

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<sup>1</sup> See, e.g., *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 756 F.2d 1556, 1560 (Fed. Cir. 1985) (holding that a jury instruction that a patent is invalid for lack of novelty if the prior art "disclosed substantially the same things" was erroneous and noting that a verdict of invalidity for anticipation should be overturned when reasonable persons could not find the evidence clear and convincing that all the claim limitations were met by the prior art reference in question).

<sup>2</sup> *Nystrom v. Trex Co.*, 374 F.3d 1105, 1117 (Fed. Cir. 2004) ("A patent is invalid as anticipated if every limitation in a claim is found in a single prior art reference."); *Merck & Co. v. Teva Pharmaceuticals USA, Inc.*, 347 F.3d 1367, 1372 (Fed. Cir. 2003) ("An 'anticipating' reference must describe all of the elements and limitations of the claim in a single reference, and enable one of skill in the field of the invention to make and use the claimed invention.").

<sup>3</sup> *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991).

claim 1, McIntosh fails to disclose populating a knowledge base in a manner required by independent claim 1. Claim 1 requires: (1) *applying at least one knowledge-base-population rule to at least one claim element to form claim-processing knowledge for the at least one claim element*; and (2) *populating the knowledge base with the claim-processing knowledge acquired from the applying step, the knowledge base being resident in a computer-readable storage medium in the computing system*. In contrast to these required features of claim 1, McIntosh teaches allowing a rules administrator to enter rules into the knowledge base expert system via a GUI. McIntosh fails to disclose the features denoted as (1) and (2) above as claimed in independent claim 1. For this additional reason, Applicant respectfully submits that claim 1 patentably distinguishes over McIntosh.

For at least these reasons, Applicant respectfully requests that the rejection under 35 U.S.C. § 102 of claim 1 be withdrawn.

**B. Claim 9**

Independent claim 9 is directed to an article of manufacture for populating a knowledge base used in validating medical claims. For reasons similar to those given with respect to independent claim 1, Applicant respectfully submits that McIntosh fails to disclose several required features of independent claim 9 including, for example, processor instructions configured to be readable from at least one computer readable medium by at least one processor and thereby cause the at least one processor to operate as to:

- (1) *create at least one claim element based on information related to a field from a claim form*;
- (2) *apply at least one knowledge-base-population rule to the at least one claim element to form claim-processing knowledge for the at least one claim element*; and
- (3) *populate the knowledge base with said claim-processing knowledge acquired from said applying step*.

Therefore, Applicant respectfully requests that the rejection under 35 U.S.C. § 102 of claim 9 be withdrawn.

**C.      *Claims 2-8 and 10-14***

Claims 2-8 depend from and further patentably restrict independent claim 1. Claims 10-14 depend from and further patentably restrict independent claim 9. For at least the reasons given with respect to independent claims 1 and 9, Applicant respectfully submits that claims 2-8 and 10-14 are also in condition for allowance. Applicant respectfully requests that the rejection under U.S.C. § 102 of claims 2-8 and 10-14 be withdrawn.

**D.      *New Claims 23-30***

New claims 23-25 and 26-28 depend from and further patentably restrict independent claims 1 and 9, respectively. Additionally, new claims 23-28 each recite features that are not disclosed by the prior art of record. For at least these reasons, Applicant respectfully submits that new claims 23-28 are in condition for allowance.

New independent claim 29 is directed to a method. Applicant respectfully submits that the prior art of record fails to disclose at least the following required features of independent claim 29:

(1)      *creating, on at least one hardware server in a computing system, a plurality of claim elements based on a plurality of fields from a plurality of claim forms, the plurality of claim elements comprising a plurality of edits, the plurality of edits representing one or more situations that hinder claim payment by a payer;*

(2)      *for each of the plurality of claim elements, applying one or more knowledge-base-population rules for a knowledge base to at least some of the plurality of edits to form claim-processing knowledge for the plurality of claim elements; and*

(3) *populating the knowledge base with the claim-processing knowledge acquired from the applying step, the knowledge base being resident in a computer-readable storage medium in the computing system.*

Applicant respectfully submits that new independent claim 29 is also in condition for allowance.

#### **IV. Conclusion**

In view of the above amendment, Applicant respectfully submits that the present application is in condition for allowance. A Notice to that effect is respectfully requested.

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Respectfully submitted,

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